

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reissue Application of:

U.S. Patent No.: 4,861,711

Patentee: Friesen et al.

Issued: August 29, 1989

Serial No.: 08/544,579

Filed: October 18, 1995

For: SHEET-LIKE DIAGNOSTIC DEVICE

Box MISSING PARTS

Group Art Unit: Unassigned

Examiner: Unassigned

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

**REISSUE DECLARATION UNDER
37 C.F.R. § 1.175 AND POWER OF ATTORNEY**

On behalf of Behringwerke Aktiengesellschaft (Behringwerke), the assignee of the entire interest in U.S. Patent No. 4,861,711 (the '711 patent), we hereby declare that:

1. We have authority to sign documents on behalf of Behringwerke. Behringwerke is the owner of the entire interest in the above-identified U.S. patent by virtue of an assignment recorded on December 13, 1985, at Reel 4496, Frame 0646.

2. We believe that the original, first and joint inventors of the subject matter which is claimed in the above-identified reissue application and for which a reissue patent is sought on the above-entitled invention are Heinz-Jürgen Friesen, Gerd Grenner, Hans-Erwin Pauly, Helmut Kohl, Klaus Habenstein, Joseph Stärk, all of whom are citizens of the Federal Republic of Germany. The above-identified reissue application was filed on October 18, 1995, and was accorded Serial No. 08/544,579.

3. We have reviewed and understand the contents of the above-identified reissue specification, including the reissue claims.

4. We acknowledge the duty to disclose information which is material to patentability as defined in 37 C.F.R. § 1.56.

5. We hereby claim foreign priority benefits under Title 35, United States Code, § 119 of the foreign applications for patent listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application on which priority is claimed:

<u>Country</u>	<u>Application No.</u>	<u>Date of Filing</u>
Federal Republic of Germany	P 3445816	December 15, 1984

6. We believe that the '711 patent may be partly inoperative or invalid by claiming more than the patentee had a right to claim. Any error that may have occurred in claiming more than the patentee was entitled to, arose without any deceptive intent on the part of the inventors or Behringwerke. The issues involved in this reissue application are related to an interference involving the '711 patent as follows.

7. The '711 patent to the party Friesen et al. (Friesen) is involved in Interference No. 103,072 against U.S. Patent Application No. 07/891,864, filed June 1, 1992 (the Guire application), to the party Guire et al. (Guire).

8. In that interference, several preliminary motions were filed. For example, Guire filed a motion attacking the patentability of the claims of the '711 patent as allegedly being unpatentable over Guire's counterpart published European Patent

Application 0 088 636 A2 alone or in combination with other references. Guire's counterpart published European Patent Application has essentially the same specification as the Guire 07/891,864 application and has a publication date before Friesen's effective filing date. A copy of Guire's motion attacking the patentability of the '711 patent is attached as Exhibit A. Copies of references cited in Guire's motion attacking patentability of the '711 patent are being submitted with the Information Disclosure Statement (IDS) accompanying this Reissue Declaration.

9. Friesen filed a motion attacking the patentability of the only two claims of the Guire application in the interference for not having support in the specification under 35 U.S.C. § 112, first paragraph. (The two claims in the Guire application are identical to the two counts of the interference.) Friesen also filed a motion requesting that claims 9 and 22 of the '711 patent be removed from the interference as being directed to separately patentable subject matter.

10. On September 27, 1994, the Administrative Patent Judge (APJ) issued a decision on the preliminary motions, including the motions discussed in paragraphs 8 and 9 above. A copy of that decision is attached as Exhibit B. The APJ granted Friesen's motion to remove claims 9 and 22 from the interference since they are directed to separately patentable subject matter. The APJ denied Friesen's motion attacking the enablement of the two claims of the Guire application. The APJ deferred to final hearing Guire's motion attacking the patentability of Friesen's

claims, since it may be moot in view of Friesen's preliminary statement that did not overcome the effective filing date of Guire's filing date. Also in view of the claimed dates in the preliminary statements, the APJ ruled that judgment would be entered against Friesen, unless within twenty days from the date of the order, Friesen showed cause why such action should not be taken.

11. In accordance with the rules of interference practices, if Friesen failed to respond to the Order to Show Cause by October 17, 1995, judgment would be entered against Friesen in the interference, as indicated by the APJ in the Order. Friesen was willing to accept the APJ's decision as long as the interference was terminated, and thus, Friesen would be entitled to its claims 9 and 22. Accordingly, Friesen did not respond to the Show Cause Order by October 17, 1994, and filed a reissue application on October 14, 1994.¹ If the interference had been terminated at that point according to the rules, the '711 patent would have been partly inoperative since it would have included original claims 1-8, 10-21, and 23-34. Those claims would have been unpatentable to Friesen on the basis of priority of invention, which would have been awarded to Guire. (Original claims 9 and 22 would have properly remained in the '711 patent in view of the APJ's decision to remove them from the interference as being separately patentable.)

¹ The reissue application filed October 14, 1994 was abandoned in favor of a reissue application filed April 18, 1995, which was abandoned in favor of the present reissue application filed October 18, 1995.

12. The APJ, however, did not terminate the interference, allowing the interference to proceed to final hearing. See the APJ's decision of February 16, 1995 (Exhibit C). The issues for final hearing included whether Guire's application lacked section 112, first paragraph, support for Guire's claims (which are equivalent to the counts of the interference), and whether Friesen's claims 9 and 22 of the '711 patent were properly removed from the interference. The APJ dismissed Guire's motion for judgment that Friesen's claims are unpatentable.

13. Both parties requested that the February 16, 1995 decision concerning the final hearing be modified. On May 5, 1995, the APJ modified his February 16, 1995 decision by allowing Guire to raise on a contingent basis at final hearing the unpatentability of Friesen's claims. A copy of the May 5, 1995, decision is attached as Exhibit D.

14. Both Guire and Friesen have filed Briefs for Final Hearing, but a final decision has not been made. If at final hearing, the Board agrees with Friesen that the Guire application fails to enable Guire's claims under section 112, first paragraph, then priority could not be awarded to Guire. Thus, claims 1-8, 10-21, and 23-34 of the '711 patent should be patentable in view of Guire not being awarded priority. Moreover, Guire's European patent application, which has essentially the same specification as the Guire application, would not be an enabling reference and thus may not adversely affect the patentability of the '711 patent.

15. If the Board decides this issue adverse to Friesen,

however, then claims 1-8, 10-21, and 23-34 of the '711 patent would be unpatentable in view of Guire being awarded priority. Thus, the '711 patent would be partly invalid.

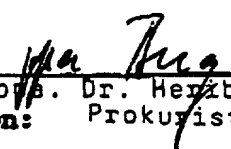
16. The reissue application omits all claims which correspond to the counts of the interference. See the sentence bridging pages 2 and 3 of the APJ's February 16, 1995 decision (Exhibit C). Thus, a decision of priority for Guire in the interference, and affirmation of the APJ's decision that claims 9 and 22 of the '711 patent are separately patentable, should not prevent the patentability of claims 1, 18 and 35-57 of the reissue application. Claims 1 and 18 of the reissue application have been amended to include the subject matter of claims 9 and 22 of the '711 patent. Thus, claims 1 and 18 of the reissue application are, in effect, the same as claims 9 and 22 of the '711 patent. Claims 35-57 of the reissue application include additional limitations not contained in the claims of the '711 patent. Those additional limitations should render claims 35-57 patentable over Guire's European patent application, even if the Board finds that the disclosure in Guire's application enables Guire's claims in the interference. Claims 35-57 have been added to the reissue application to protect subject matter disclosed in the Friesen application. Such narrower scope claims will be needed if the Board finds that Friesen is not entitled to claims 1-8, 10-21, and 23-34 in the '711 patent.

17. We hereby appoint the following attorneys to prosecute this application and transact all business in the U.S. Patent and Trademark Office connected herewith: Jerry D. Voight, Reg. No.

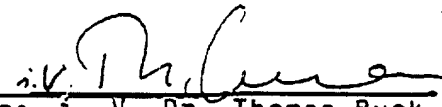
23,020; Thomas L. Irving, Reg. No. 28,619; M. Paul Barker, Reg. No. 32,013; and Alan W. Hammond, Reg. No. 35,178. Please address all correspondence to PINNEGAN, HENDERSON, PARABOW, GARRETT & DUNNER, L.L.P., 1300 I Street, N.W., Suite 700, Washington, D.C. 20005-3315; Telephone No. (202) 408-4000.

18. We hereby declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the reissue application or any reissue patent issued thereon.

Dated: 07 May 1996


Name: p/a. Dr. Herbert Bug
Position: Prokurist

Dated: 07 May 1996


Name: i. V. Dr. Thomas Buck
Position: Handlungsbevollmächtigter